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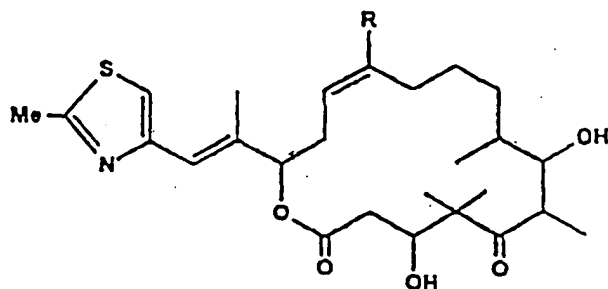
wherein R is hydrogen or methyl. --

REMARKS

Claim 17 has been added to this application for the purpose of initiating an interference with U.S. Patent No. 6,156,905 to Schinzer et al. Claim 17 corresponds substantially to claim 1 of U.S. Patent No. 6,156,905. The following count is proposed to define the interference subject matter:

Proposed Count 1:

An epothilone of the formula:



wherein R is hydrogen or methyl.

Proposed count 1 complies with 37 C.F.R. §1.606 in that it is not narrower in scope than any patent claim or application claim which corresponds to the count.

Identification of at Least One Claim in U.S. Patent No. 6,156,905 Corresponding to the Proposed Count

Proposed count 1 corresponds substantially to claim 1 of U.S. Patent No. 6,156,905 with the following exceptions:

- (1) the term "deoxy -" is omitted from proposed count 1,
- (2) the designation "19a" has been omitted from proposed count 1,
- (3) the stereoconfigurations shown in claim 1 of U.S. Patent No. 6,156,905 are not used in proposed count 1, and

- (4) the designation "OB" in the formula of U.S. Patent 6,156,905, claim 1, have been changed to - OH - as required by the last line of claim 1 of U.S. Patent No. 6,156,905.

None of these differences renders the proposed count as not corresponding substantially to claim 1 of U.S. Patent No. 6,156,905. These differences are necessary since applicants do not have basis in their application for the differences noted in paragraphs 1, 2 and 3 above.

Presentation of Claim Corresponding
to the Proposed Count

Claim 17 presented with this Amendment corresponds exactly to proposed count 1.

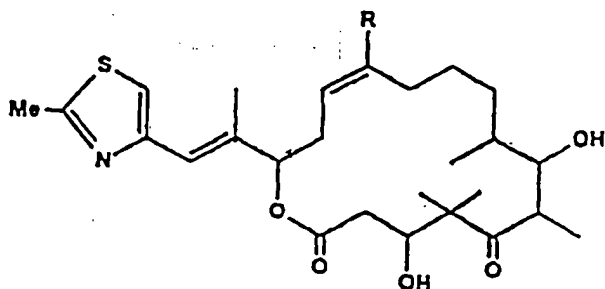
Application of the Terms of Claim 17
to the Disclosure of the Application

The terms of claim 17 are applied to the disclosure of the application as follows:

Term of Claim 17

An epothilone

of formula



wherein R is hydrogen or methyl

Disclosure of Application

page 1, lines 10 and 11

page 8, lines 20, 21 and 22

page 8, lines 21 and 22

Affidavit or Declaration Under
37 C.F.R. §1.608 is Not Required

The present application claims priority of Federal Rep. Germany Application 196 47 580.5 which was filed November 18, 1996. A certified copy of this application was attached as Appendix C to an Amendment filed in this application on or about April 20, 2001. This

application describes preparation and compositions of epothilones C and D. The claims of the present application are directed to epothilones C and D which are generically claimed in claim 17 submitted herewith. Thus, the effective filing date of this application is November 18, 1996.

Attached to the Amendment filed on or about April 20, 2001 as Appendix B is a certified copy of U.S. Provisional Application No. 60/027,480 which is the provisional application that serves as the parent of U.S. Patent No. 6,156,905. That provisional application does not disclose epothilone C and D or the subject matter of claim 1 of U.S. Patent No. 6,156,905 to Schinzer et al. As such, the filing date of U.S. Provisional Application No. 60/027,480 cannot be used as a date for disclosure of epothilone C and D in U.S. Patent No. 6,156,905. Accordingly, the earliest filing date to which U.S. Patent No. 6,156,905 is entitled for the subject matter of claim 1 of that patent is the filing date of grandparent Application Serial No. 08/921,512, i.e., September 2, 1997. Thus, the effective filing date of the present application predates the effective filing date of U.S. Patent No. 6,156,905 and no affidavit or declaration under 37 C.F.R. §1.608 is necessary.

Rejection of Claims 1-4, 15 and 16 As Being
Anticipated By Either Schinzer et al. Patent is Traversed

Claims 1-4, 15 and 16 have been rejected in the Office Action dated September 4, 2001 under 35 U.S.C. §102(e) as being anticipated by either Schinzer et al. patent, i.e., U.S. Patent No. 5,969,145 and U.S. Patent No. 6,156,905. This rejection is respectfully traversed.

At the outset, it is noted that this rejection should be based on 35 U.S.C. §102(g) rather than 35 U.S.C. §102(e), since neither of the Schinzer et al. patents has an effective filing date which antedates the effective filing date of this application. Therefore, the Schinzer et al. patents are not references against the present application under 35 U.S.C. §102(e).

The Office Action states that the “references is a U.S. patent that claims the rejected invention” and notes that the patent can be only be overcome by establishing priority of

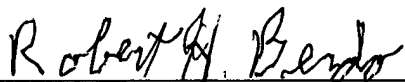
invention through interference proceedings. However, it is respectfully submitted that this comment only applies to U.S. Patent No. 6,156,905 and applicants by this paper, are requesting an interference with that patent.

U.S. Patent No. 5,969,145 contains two claims. Claim 1 recites a process for the production of epothilone A or B, and claim 2 claims a deoxy epothilone wherein one of the hydroxy groups is replaced with a specifically defined protecting group. Thus, neither of these claims read on the invention defined in claims 1-4, 15, 16 and 17 of this application.

Conclusion

In view of the foregoing, it is respectfully requested that this application be placed in interference with U.S. Patent No. 6,156,905.

Respectfully submitted,



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